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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,833	12/28/2000	Judith C. Espejo	BS00-131	5208

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EXAMINER	
LEE, JOHN J	
ART UNIT	**PAPER NUMBER**
2618	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/749,833	ESPEJO ET AL.	
	Examiner	Art Unit	
	JOHN J. LEE	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/21/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1 - 13 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 – 13 are rejected on the ground of nonstatutory double patenting over claims 1 - 20 of U. S. Patent No. 7,088,087 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: present application is obvious in view of the claims 1

– 20 of the U.S. Patent No. 7,088,087. Specifically, The claims of U.S. Patent (7,088,087) are the same limitation/function of the invention as claimed of present application. More specifically, the independent claim 1 of the present application is the same principle invention as claims 1 and 7 of the U.S. Patent (7,088,087) plus additional elements.

Also, the dependents claims of the present application are the same principle invention as the claims of the U.S. Patent (7,088,087).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 1- 6, 10, 11, and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson (US Patent number 6,327,363) in view of Stevens (US 6,404,880).

Regarding **claim 1**, Henderson discloses that a communication system providing interactive voice response for services (column 2, lines 45 – column 3, lines 61 and Fig. 2). Henderson teaches that a switching system (302 in Fig. 3), adapted to communicate with at least one device (300 in Fig. 3), capable of establishing a control channel and a voice channel with the device (Fig. 2, 3 and column 5, lines 25 – column 6, lines 60 where teaches communication system, switching system, communicates with voice, data and control data via communication device). Henderson teaches that a Service Control Point (SCP) (400 in Fig. 4) in communication with the switching system (302 in Fig. 3) (Fig. 4 teaches SSCP communicates with the switching system by 307 and see column 7, lines 42 – column 8, lines 7), the SCP including an Interactive Voice Response (IVR) application (408 in Fig. 4) for prepaid customers, and capable of retrieving customer information (column 7, lines 42 – column 8, lines 64 and Fig. 4, where teaches SCP including Voice Response (IVR) application for prepaid customers to provide customer information). Henderson teaches that an Intelligent Peripheral (402 in Fig. 4) in communication with the SCP (400 in Fig. 4) and the switching system (302 in Fig. 3), the Intelligent Peripheral (402 in Fig. 4) including IVR messages and adapted to send those messages through a voice channel (speech signal) to the switching system (column 7, lines 42 – column 8, lines 64 and Fig. 4, where teaches Intelligent Peripheral communicates with SCP and the switching system, having IVR messages are driven by

IVR applications that execute on SCP and receives the message through speech signal to the switching system). Henderson also teaches that wherein the switching system (302 in Fig. 3) communicates with the SCP (400 in Fig. 4) and wherein the SCP communicates with the Intelligent Peripheral (402 in Fig. 4) (column 7, lines 42 – column 8, lines 64 and Fig. 4).

Henderson does not specifically disclose the limitation "a wireless system providing mobile switching center and wireless device for communicating with each other over the air". However, Stevens teaches the limitation "a wireless system providing mobile switching center and wireless device for communicating with each other over the air" (Fig. 1 and column 6, lines 10 – column 7, lines 65, where teaches a wireless system including mobile switching center, service control point (SCP), Intelligent Peripheral, a wireless device are communicating each other with IVR messages for prepaid service). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Henderson system as taught by Stevens. The motivation does so would be to achieve an efficient mobility and reliability communication for prepaid customers in wireless communication system.

Regarding **claim 2**, Henderson teaches that the system is adapted to route a calling party (customer) to the IVR when the system receives a predetermined dialed number (toll-free dial number) (column 5, lines 52 – column 6, lines 26 and Fig. 2).

Regarding **claim 3**, Henderson teaches that the predetermined dialed number is an abbreviated number (pin number) (column 5, lines 52 – column 6, lines 26 and Fig. 2).

Regarding **claim 4**, Henderson teaches that the predetermined dialed number is an abbreviated number shorter than seven digits (could be used speed dial number) (column 5, lines 52 – column 6, lines 26 and Fig. 2).

Regarding **claim 5**, Henderson teaches that the predetermined dialed number is a three digit code (could be used speed dial number) (column 5, lines 52 – column 6, lines 26 and Fig. 2).

Regarding **claim 6**, Henderson teaches that the predetermined dialed number is x11, where x is an integer (column 5, lines 52 – column 6, lines 26 and Fig. 2, where teaches predetermined dialed number used to be operating prepaid services and carriers for example "*69" or "*11").

Regarding **claim 7**, Henderson and Stevens teach all the limitation as discussed in claim 1. Furthermore, Henderson further teaches that the SCP communicates with the switching system using Intelligent Network Transactional Capabilities Application Part messaging (column 6, lines 40 – column 7, lines 60 and Fig. 3, 4, where teaches supporting TCP/IP and Transactional Capabilities Application Part messaging, to ISN for accessing operator assistance services, network data, and other intelligent services).

Regarding **claims 8, 10, and 11**, Henderson and Stevens teach all the limitation as discussed in claim 1. Furthermore, Henderson further teaches that SCP communicates with switching system using TCP/IP, and with the Intelligent Peripheral using TCP/IP and Intelligent Network Transactional Capabilities Application Part messaging (column 6, lines 40 – column 7, lines 60 and Fig. 3, 4, where teaches SCP communicates with switching system and the Intelligent Peripheral, and switching system communicates

using TCP/IP, and Intelligent Peripheral communicates using TCP/IP and Transactional Capabilities Application Part messaging).

Regarding **claim 9**, Henderson and Stevens teach all the limitation as discussed in claim 1. Furthermore, Henderson further teaches that the SCP communicates with the intelligent Peripheral using Intelligent Network Transactional Capabilities Application Part messaging (column 10, lines 6 – column 11, lines 56 and Fig. 5, 7, where teaches SCP communicates with Intelligent Peripheral that response the voice messages using ISN application processor (INAP) through the communication line to the switching system).

Regarding **claim 12**, Henderson teaches that the SCP communicates with an intelligent Peripheral using Intelligent Network Transactional Capabilities Application Part messaging (column 10, lines 6 – column 11, lines 56 and Fig. 5, 7, where teaches SCP communicates with Intelligent Peripheral that response the voice messages using ISN application processor (INAP) through the communication line to the switching system).

Regarding **claim 13**, Henderson and Stevens teach all the limitation as discussed in claim 1. Furthermore, Henderson further teaches that the SCP communicates with an intelligent Peripheral, and wherein the Intelligent Peripheral plays voice messages through a voice path to the switching system (column 10, lines 6 – column 11, lines 56 and Fig. 5, 7, where teaches SCP communicates with Intelligent Peripheral that response the voice messages through the communication line to the switching system).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Laybourn et al. (US 6,480,710) discloses Managing Prepaid Wireless Service.

Shupe et al. (US 6,771,950) discloses a Wireless Subscriber to Initiate a Calling Party Number Trace.

Information regarding...Patent Application Information Retrieval (PAIR) system... at 866-217-9197 (toll-free)."

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
Or P.O. Box 1450
Alexandria VA 22313

or faxed (571) 273-8300, (for formal communications intended for entry)

Or: (703) 308-6606 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to USPTO Headquarters, Alexandria, VA.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(571) 272-7880**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Edward Urban**, can be reached on **(571) 272-7899**. Any inquiry of a general nature or

relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

J.L
January 16, 2007

John J Lee